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SCHIFF, HARDIN LLP

PATENT DEPARTMENT

6600 SEARS TOWER

233 SOUTH WACKER DRIVE

CHICAGO, ILLINOIS 60606

IN RE APPLICATION OF:

Bernhard SCHOLZ

GROUP ART UNIT: 3736

SERIAL NO.:

10/614,944

EXAMINER: F. A. Smith

FILED:

July 8, 2003

CONFIRMATION NO.: 8935

TITLE:

"METHOD FOR LOCALIZING AT LEAST ONE FOCAL LESION IN A BIOLOGICAL TISSUE SECTION"

RESPONSE TO THE JUNE 16, 2006 OFFICE ACTION ACCOMPANYING FILING OF RCE**MAIL STOP RCE - AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

SIR:

Transmitted herewith is an amendment in the above-identified application.

☐ No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	*2	MINUS	20	X	() X 25.00 () X 50.00	
INDEP. CLAIMS	1	MINUS	3	X	() X 100.00 () X 200.00	
Application amended to contain any multiple dependent claims not previously paid for.				() YES () NO	() \$180.00 () \$360.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$0.00

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

****** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

☐ Applicants petition the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated _____ for _____ months so that the period for response is extended to _____. A check in the amount of \$_____ is attached to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to deposit account No. 501519. A duplicate copy of this sheet is enclosed.

☐ A check in the amount of \$_____ is attached.

☐ A check for \$_____ accompanying IDS under 37 CFR 1.97(c) is attached

☐ A check for \$_____ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519. A duplicate of this sheet is enclosed.

When phoning re this application, please call (312) 258-5500.

SCHIFF, HARDIN LLP (Customer Number: 26574)

Patent Department

BY

(28,982)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 5, 2006.

Steven H. Noll

NAME OF APPLICANT'S ATTORNEY

SIGNATURE

September 5, 2006

DATE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RESPONSE TO THE JUNE 16, 2006 OFFICE ACTION ACCOMPANYING FILING
OF RCE**

APPLICANT: Bernhard Scholz GROUP ART UNIT: 3736
SERIAL NO.: 10/614,944 EXAMINER: Fangemonique A. Smith
FILED: July 8, 2003 CONFIRMATION NO.: 8935
TITLE: METHOD FOR LOCALIZING AT LEAST ONE FOCAL LESION
IN A BIOLOGICAL TISSUE SECTION

MAIL STOP AF

Commissioner for Patents
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S I R:

Applicant and his counsel have carefully reviewed the Office Action dated June 16, 2006, but believe claim 1 in its present form is patentable over the teachings of the reference relied upon by the Examiner. Reconsideration of the application in view of the following arguments in support of patentability is therefore respectfully requested.

REMARKS

In the Office Action dated June 16, 2006, claim 1 was rejected under 35 U.S.C. §102(e) as being anticipated by Nachaliel et al. In substantiating this rejection, the Examiner stated, among other things, that the Nachaliel et al. reference discloses method steps including determining the depth position, in a subject, of a lesion using orthogonal lead fields. The Examiner cited column 3, lines 14-35 and column 20, lines 20-53 in substantiation of this statement.